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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,462	12/13/2004	Tadashi Nakamura	TOS-157-USA-PCT	7551
27955	7590	01/28/2008	EXAMINER	
TOWNSEND & BANTA c/o PORTFOLIO IP PO BOX 52050 MINNEAPOLIS, MN 55402			KAROL, JODY LYNN	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/501,462	Applicant(s) NAKAMURA ET AL.	
	Examiner Jody L. Karol	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/2007 and 11/29/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the amendments and remarks submitted on 11/13/2007. Claims 1-7 are pending and examined on the merits herein.

Information Disclosure Statement

1. The information disclosure statement (IDS) filed 11/13/2007 and 11/29/2007, are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered. However, JP 11-5712 and JP 10-226622 have not been considered because an English language translation was not provided and the IDS do not provide enough information to determine their relevancy to the invention.

Response to Arguments - Summary

2. In view of Applicant's amendments and remarks, the objection to the specification in regards to the abstract, layout, trademarks, and title, are herein withdrawn.

3. The rejection of claims 1-7 under 35 U.S.C. 112, 2nd paragraph as being indefinite are herein withdrawn in view of Applicant's amendment to claim 1.

4. The Applicant's argument that the doubling patent rejection was improper was not found persuasive and thus the rejection is upheld. A provisional double patenting rejection on co-pending claims is deemed proper. See MPEP § 804. The double patenting rejection is therefore maintained for the reasons previously stated on the record.

5. The Applicant's arguments with respect to the rejection of claims 1-7 under 35 U.S.C. 103(a) were fully considered but were not found persuasive, and thus the rejection is maintained. See further explanation below.

The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied in the instant application. The newly applied objections are necessitated by the amendment submitted on 11/13/2007.

Claim Objections

6. Claims 3 and 5 objected to because of the following informalities: Claims 3 and 5 have been amended to include "and" prior to gellan gum. However, "and" is already

present prior to alginic acid, and the additional "and" is not necessary. Appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 7, 11 and 16 of copending Application No. 09/936317 in view of the machine translation of unexamined patent publication JP 2000-219609 A by Sato et al.

Although the conflicting claims are not identical, they are not patentably distinct because the instant claims are drawn to a composition comprising a microgel having an average particle size of 0.1-1,000 micrometers obtained by dissolving a hydrophilic

compound having a gelation ability in water or an aqueous component, letting it cool down and solidify to form a gel, and pulverizing said gel, while the copending claims are drawn to the process for producing the microgel. Both claim sets further limit the particle size of the microgel to 1 to 300 micrometers and list agar, gelatin, gellan gum, and alginic acid as possible hydrophilic compounds. The instant claims further require the composition to contain an organophilic clay mineral, an oil component, and an emulsifier with an HLB value no greater than 7. The copending claims also claim a process for producing an external cosmetic composition, but do not specify the other ingredients present in the cosmetic composition. However, water-in-oil emulsions that contain organophilic clay minerals in the oil phase are well-known cosmetic formulations. For example, Sato et al. discloses a water-in-oil emulsified composition comprising a silicone oil phase, an organically modified clay mineral, and emulsion aid of having an HLB value of 7 or less that is useful in cosmetic compositions because of its high stability at low temperatures (see abstract). Therefore, it would be obvious to one of ordinary skill in the art that a cosmetic composition containing a microgel could be a water-in-oil emulsion where the oil phase contains an organophilic clay mineral and an emulsifier with an HLB value less than 7, so as to increase the stability of the composition. Accordingly, the instant claims 1-7 are obvious over the copending claims 1, 5, 7, 11 and 16 in view of Sato et al. (JP 2000-219609 A), and thus are not patentably distinct over the copending Application No. 09/936317.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delrieu et al. (US 5,961,990) in view of Sato et al. (JP 2000-219609 A).

Claim 1 is directed to a water-in-oil emulsified composition comprising (a) 0.1-20% by weight organophilic clay mineral, (b) 10-70% by weight oil component, 0.1-10% by weight emulsifier having an HLB value of not more than 7, and (d) 0.1-90% by weight microgel having an average particle size of 0.1 to 1,000 micrometers. The microgel is said to be obtained by dissolving a hydrophilic compound having a gelation ability in

water or an aqueous component, letting it cool down and solidify to form a gel, and pulverizing said gel. Claim 2 further limits the particle size of the microgel to 1-300 micrometers. Claim 3 specifies that the hydrophilic compound is selected from the group consisting of agar, carrageenan, curdlan, gelatin, gellan gum, and alginic acid. Claims 4-7 are directed to cosmetic compositions of claims 1-3. The term "comprising" is interpreted to be broad and open, indicating that other components may be present in the composition.

Delrieu et al. teaches water-in-oil cosmetic compositions that contain agar gel particles (see column 4, lines 6-9 and columns 11-12, lines 63-67, 1-17). Delrieu et al. also specifies that the gel beads can be present in a cosmetic composition in 0.1 to 90% by weight of the total composition (see column 12, lines 18-22) and that the gel particles can range in size between 50-10,000 micrometers (see column 5, lines 42-52).

Delrieu et al. teaches that recipes and ingredients for cosmetic compositions are well known to those of ordinary skill in the art (see column 12, lines 3-9). However, Delrieu et al. does not explicitly teach cosmetic compositions where the other ingredients are specifically disclosed, or the specific percentages for the components.

Sato et al. teaches water-in-oil emulsified compositions comprising a silicone oil phase, an organically modified clay mineral, and an emulsion aid having an HLB of 7 or less, and is important for its disclosure of an organophilic clay mineral and emulsifier having an HLB value of 7 or less in the oil phase (see abstract). The clay mineral is present in the composition in 0.1 to 10% by weight, and the emulsifier is present in 0.1 to 15% by weight (see page 10, section 33 and page 11, section 42). This significantly

overlaps with the % weights listed in the instant claims for these components. Sato et al. also discloses that the compositions are useful as cosmetic compositions and afford high stability at low temperatures (see abstract).

It is well known in the art that blending a solid into the oil phase of a water-in-oil emulsion increases the viscosity of the oil phase, resulting in emulsions with higher stability. Therefore, it would be obvious to one of ordinary skill in the art, at the time the invention was made, to include an emulsifier and an organophilic clay mineral in the oil phase of a water-in-oil emulsion as taught in Sato et al., to increase the viscosity of the oil phase and the overall stability of the emulsion of Delrieu et al.

Response to Arguments

10. The Applicant argues that the agar gel particles in Delrieu et al. containing a restraining polymer dispersed in the agar gel differ from the microgel called for in claim 1 of the instant application. Is the view of the Examiner that the microgel of claim 1 is the same as the gel taught by Delrieu et al. The microgel of the instant invention is not limited to a hydrophilic compound (i.e. agar) and water, and therefore the gel particles of Delrieu et al. that additionally contain restraining polymer are not excluded by the claims. Furthermore, the gels are both produced by the dissolving the agar in water above the gellation temperature, cooling to below the gellation temperature, and then breaking up the gel (i.e. pulverizing, discharging through a needle).

11. The Applicant argues that there is no teaching, suggestion, or motivation in either of the references to combine them. The Applicant further argues that the reasons given for the combining the references are identical to those in the specification and that the specification indicates that an undesirable stickiness will result when solid or semi-solid oils are blended into the oil phase. As previously stated, it is well known in the art that blending a solid into the oil phase of a water-in-oil emulsion increases the viscosity of the oil phase, resulting in emulsions with higher stability. In the instant invention, solids blended into the oil phase are organophilic clay minerals. Sato et al. teaches that water-in-oil emulsions with organically modified clay minerals and an emulsion aid having an HLB of 7 or less, afford emulsions with high stability, particularly at low temperatures (see abstract). Furthermore, Sato et al. specifically teaches that organic denaturation argillites (organic modified clay minerals) are used in water-in-oil emulsions to reduce the amount of semi-solid oil present in the oil phase to improve the usability and temperature stability (see pages 2-3, section 2). It is the view of the Examiner that the organically modified clay minerals taught by Sato et al. are the same as the organophilic clay minerals of the instant invention.

12. In response to the Applicant's argument on pp. 12-13 of the reply, the Examples in the specification have been fully considered. However, it appears that the difference in sensation and/or stability is due to the gelling agent used (e.g. carboxyvinyl polymer vs. agar) rather than to the presence or absence of the claimed ingredients in the oil phase (e.g. oil phase components, clay, emulsifier).

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

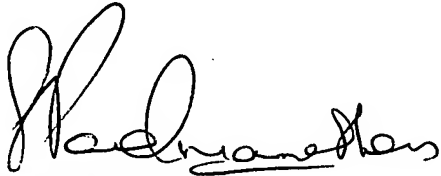
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jody L. Karol whose telephone number is (571) 270-3283. The examiner can normally be reached on 8:30 am - 5:00 pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JLK


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER